

PRE-APPEAL BRIEF REQUEST FOR REVIEW
- Expedited Examining Procedure -
Examining Group 1792

MAIL STOP AF
N81438/AJA
Customer No. 01333

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of
Inventor(s):
Jiann-Hsing Chen, et al.

METHOD FOR PRODUCING A
REPLACEABLE FUSER MEMBER

Serial No.: 10/662,913
Filed: September 15, 2003

Group Art Unit: 1792

Examiner: Elena Tsoy Lightfoot

Confirmation no. 1253

Commissioner for Patents
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicants request pre-appeal brief review of the final Office Action dated April 30, 2009, and the Advisory Action dated August 06, 2009, in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal.

Claims 1-3, 5-6, 8-11, 14, and 16-18 have been finally rejected under 35 U.S.C. 103(a) over Applicants' admitted prior art and applied as evidence Shifley et al. (US 6,269,873), Hartley et al. (US 4,853,737) and Chen et al. (US 5,781,840), and further in view of Wallin (US 3,799,859), Kawada et al. (JP 200131864), Bird et al. (US 3,552,898) and Weber et al. (US 4,750,160) for the reasons of record set forth in paragraph 2 of the Office Action mailed on 10/21/2008 because typical hollow cylinder cores described by Applicants' admitted prior art read on claimed sleeve.

Claims 1-3, 5-6, 8-11, 14, 16-18, 21, 23, and 25 have been finally rejected under 35 U.S.C. 103(a) over Applicants' admitted prior art in view of Shifley et al., Wallin, Kawada et al., Bird et al., Weber et al., Hartley et al., and Chen et al., as applied above, and further in view of Badesha et al. (US 5,141,788) for the reasons of record set forth in paragraph 8 of the Office Action mailed on 10/10/2006.

Claims 1-3, 5-6, 8-11, 14, 16-18, and 21-25 have been finally rejected under 35 U.S.C. 103(a) over Applicants' admitted prior art in view of Shifley et al., Wallin,

Kawada et al., Bird et al., Weber et al., Hartley et al., and Chen et al., as applied above, and further in view of Petropoulos et al. (US 5,021,109), the Examiner further arguing it would have been obvious to have used a nickel mandrel in Applicants' admitted prior art in the cited prior art because Petropoulus et al teach that typical mandrel materials include metals such as aluminum, stainless steel, nickel, chromium, copper, brass, and the like.

Claim 18 has been finally rejected under 35 U.S.C. 103(a) over Applicants' admitted prior art in view of Shifley et al., Wallin, Kawada et al., Bird et al., Weber et al., Hartley et al., and Chen et al., as applied above, and further in view of Schlueter, Jr. et al. (US 5,995,796) for the reasons of record set forth in paragraph 11 of the Office Action mailed on 10/10/2006.

It is respectfully urged that each of the final rejections represent clear error, to the extent they are based on "Applicants' admitted prior art" in the form of the preamble of original claim 19, as Applicants have submitted a Declaration of Jiann H.Chen & Joseph A Pavlisko Under 37 CFR 132 which clearly establishes that the preamble of original claim 19 refers to work done by the Declarants, which to the best of their knowledge was not publically disclosed before the filing of the instant application, and thus clearly overcomes any "presumption" that such preamble is "admitted" prior art. Despite such Declaration, the Examiner argues in the Final rejection that the preamble of original claim 19 is not Declarants' own work "because hollow fuser members were known in the art, as evidenced by US 5,141,788 to Badesha et al" (Final Rejection, page 2). Such argument by the Examiner represents clear error, as while there may be actual prior art that discloses subject matter that may be similar to certain individual elements referred to in the preamble of original claim 19, this has no bearing on whether the preamble of claim 19 itself, and in its entirety, is admitted to be "prior art" by the Applicant such that it can be relied upon in its entirety as prior art in any asserted rejection. Thus, to the extent all of the asserted rejections continue to rely upon alleged "admitted prior art" in the form of the preamble of original claim 19, such rejections are in clear error, as any presumption of admission based on the format of original claim 19 has clearly been overcome.

In response to Applicants' arguments, the Advisory Action mailed 08/06/2009 at page 2 thereof cites a further reference (not applied in any rejection) to

Gregory (US 3751216), apparently as evidence of obviousness of replacing the hollow cylinder core of Badesha et al. by removing only the hollow cylinder core mounted on a mandrel (note; there is any event no mandrel in Fig. 1 Bedesha et al as asserted by the Examiner). Again, such references to additional bits and pieces of actual prior art references which may be similar to some of the individual elements of the work described in the preamble of original claim 19, or arguments as to obviousness of combining various actual prior art references, does not in any way establish that the preamble of original claim 19, in itself and in its entirety, is “admitted” prior art as applied in the asserted rejections.

Applicants do not assert that the individual elements of the actual prior art references as set forth in the asserted rejections is not prior art, but rather that the Examiner cannot rely as the specific combination of all features set forth in the preamble of original claim 19 as “admitted prior art.” In such regard, the Badesha et al and Gregory references cited as “evidence” that the preamble of original claim 19 is not Declarants’ own work clearly do not disclose all of the elements of the preamble of claim 19 (in particular, while a hollow cylinder core for a fuser roll may be disclosed in Badesha et al, there is no disclosure that such hollow cylinder core is adapted to be positioned on a machine mandrel in a fuser system, and no disclosure that the fuser roll is produced by mounting the hollow cylinder core on a mandrel configured to receive the hollow core over the outside of the mandrel and performing the steps of applying, curing and machining specified coatings while the hollow cylinder core is mounted on the mandrel, and while Gregory may disclose a replaceable shell mounted about a roll, there is no disclosure that the shell is produced by mounting the shell on a mandrel configured to receive the shell over the outside of the mandrel and performing the steps of applying, curing and machining specified coatings while the shell is mounted on the mandrel). Thus, such Badesha et al and Gregory references are clearly deficient as to establishing that the preamble of original claim 19 in its entirety is prior art.

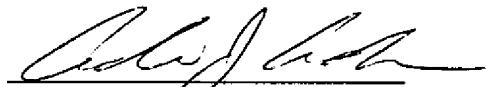
Regarding the actual asserted rejections, absent the clearly improper reliance upon the alleged “admitted prior art” in the form of the preamble of original claim 19, there is no cited actual prior art (including any actually admitted prior art) that is directed to forming a replaceable fuser roller member by a method comprising the required claim steps of mounting a nickel sleeve on a mandrel being configured to receive the sleeve over the outside of the mandrel, and performing the steps of

applying, curing and machining specified coatings while the nickel sleeve is mounted on the mandrel as required in the claimed invention. The Examiner cites many references in the various the rejections, but none of it teaches or suggests such claim requirements. The cited “reasons of record” further improperly rely upon Shifley et al as teaching replaceable fuser rollers, which as now acknowledged by the Examiner is clearly in error. For all these reasons, the final rejections “for the reasons of record” clearly fail to establish a *prima facie* case of obviousness, and instead represent clear error.

The final rejection and Advisory action represent further clear error, to the extent they fail to address Applicants’ arguments that (i) Wallin would not be applicable to the present claimed invention as the present invention is not directed towards formation of a metal belt on a mandrel, and further that the claimed relative percentage of thermal expansion are intended to provide reasonable matching of coefficients of thermal expansion to minimize differential expansion (see, e.g., page 5, lines 16-24), while the cited Wallin reference is directed towards employing materials with intentionally mis-matched coefficients (see, e.g., page 5 of Applicants’ response filed 07/31/2009); (ii) that the Examiner’s further argument that Wallin in any event would be applicable to the present invention as the present invention is directed towards “formation of a metal cylindrical belt on a mandrel” is in clear error, as the claimed invention is not directed towards formation of a metal cylindrical belt itself on a mandrel, but rather, the invention describes mounting a nickel sleeve (i.e., the sleeve is already pre-formed) on a mandrel, and the subsequent formation of various layers on the mounted nickel sleeve (see, e.g., page 6 of Applicants’ response filed 07/31/2009); and (iii) that while Petropoulos et al may disclose nickel as a typical mandrel material, Petropoulos et al is directed towards a method of forming a multilayered belt comprising a polymeric material substrate, rather than coatings on a nickel sleeve, and that accordingly, to the extent Petropoulos might teach use of a nickel mandrel, it clearly does not teach or suggest employing such a nickel mandrel in combination with a nickel sleeve (see, e.g., page 8 of Applicants’ response filed 07/31/2009). Reconsideration and withdrawal of all rejections upon review is accordingly respectfully urged.

For at least the above reasons, the final Office Action is in clear error, the Examiner having failed to assert a *prima facie* case of obviousness with regard to all features of the claimed invention. Reconsideration and withdrawal of the rejections of all claims are in order and are respectfully requested. A prompt and favorable action in response to this request is earnestly solicited.

Respectfully submitted,



Attorney for Applicant(s)
Registration No. 33,564

Andrew J. Anderson
Rochester, NY 14650
Telephone: 585-722-9662
Facsimile: 585-477-1148

If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.